

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Chris Udo MAEDING

Group Art Unit: 3741

Appln. No. : 10/579,201

Examiner: Andrew H. Nguyen

Filed : May 12, 2006

Confirmation No.: 8924

For : INJECTION ELEMENT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Examiner's election of species requirement of July 9, 2009, the time set for response extending until August 10, 2009 (as August 9, 2009, is a Sunday) Applicant hereby elects with traverse, Species I, which is directed to Figure 1A. Applicant submits that, in addition to the generic claims identified by the Examiner, i.e., claims 12, 22, and 28, claims 13 – 15, 17, 18, 20, 21 and 29 – 32, as readable on the elected species and generic to each of the identified species. The above election is made with traverse for the reasons set herein below.

In the election of species requirement of July 9, 2008, the Examiner improperly indicated that all claims (12 – 32) were subject to election under 35 U.S.C. § 121. The Examiner has required an election of one of the following species:

Species I – Figure 1A;

Species II – Figure 1B;

Species III – Figure 2A;

Species IV – Figure 2B;

Species V – Figure 4;

Species VI – Figure 5; and

Species VII – Figure 6.

The Examiner asserts that the species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. Additionally, the Examiner states that these species are not obvious variants of each other based on the current record.

Applicant has elected Species 1 directed to Figure 1A with traverse. Moreover, Applicant acknowledges that, upon allowance of a generic claim, the claims directed to the subject matter of the non-elected species will be rejoined and examined on their merits. The Examiner has identified at least claims 12, 22 and 28 as generic.

Applicant respectfully submits that, as the instant application is a U.S. National Stage Application filed under 35 U.S.C. § 371, the pending restriction requirement is *per se* improper because the Examiner has neither identified nor applied the correct legal standard for evaluating a restriction/election requirement of a National Stage application.

Accordingly, the Examiner's basis for the restriction is improper for the following reasons: first of all, the Examiner has failed to properly construe and consider the claims under the "special technical feature" standard and, furthermore, based upon this standard, the election is clearly improper.

The standard, as described clearly in M.P.E.P. sections 1850 and 1893.03(d), is not whether one group of claims has a feature which is not in another group (as erroneously asserted or implied by the Examiner in comparing the figures), but whether the groups can be read to

have a common technical relationship, i.e., whether a special technical feature is common to the groups. Accordingly, if each of the groups can be read to have one or more common special technical features or relationships, then they simply cannot be restricted.

In this case, the technical relationship or technical features common to all of the claims are at least the features recited in independent claims 12, 22, and 28 which the Examiner has identified as being generic. Applicant emphasizes that each of the figures noted in the species groups have in common at least each of the features recited in the independent claims. Thus, it is submitted that the Examiner has clearly disregarded the claim language in an erroneous attempt to support the restriction requirement that is otherwise clearly improper under PCT Rules 13.1 and 13.2.

Further, M.P.E.P. 1850 paragraph "A" makes clear that dependent claims cannot be separated from Independent claims because the "unity of invention" standard must be evaluated on the basis of independent claims only. Accordingly, since the only independent claims are 12, 22, and 28 and since these independent claims are clearly generic to each of the figures, none of the claims can be properly restricted as species under the unity of invention standard. Applicant emphasizes that any species election, much less, one that is based upon the specification disclosure, figures or dependent claims, is an improper basis for restriction under the unity of invention standard.

Accordingly, Applicant submits that under the "unity of invention" standard, the Examiner has set forth no proper basis for restricting the invention to any of the groups or species.

Applicant further points out that all of the claims clearly relate to a common subject matter as discussed above. Accordingly, the recitations of each of the independent claims, as

well as the various dependent claims are so closely related for examination purposes as to make the restriction requirement entirely inappropriate under any proper basis. For this reason alone, it is submitted that restriction is inappropriate and that all the claims in the present application should be examined together.

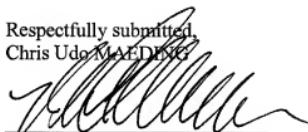
Furthermore, it is believed that the features shown in each of Species I - VII are not materially different, so as to constitute distinct inventions, for examination purposes. As the Examiner must acknowledge, they all relate to an injection element. Therefore, the searches must be at least somewhat overlapping for the groups. Thus, no undue burden is placed on the Examiner when examining all of the claims together. Consequently, it is believed that all the claims, i.e., claims 12 - 32 relate to a single inventive concept which share a common technical relationship of feature.

For all these reasons, and consistent with the office policy as set forth in M.P.E.P. §§ 803, 1850 and 1893.03(d), Applicant respectfully requests that the Examiner reconsider the position taken in the above-mentioned Official Action and withdraw the election requirement in the present application. Accordingly, the Examiner's restriction requirement is believed to be entirely improper and inconsistent with current USPTO guidelines, and has been traversed for the reasons set forth above.

For all of the above reasons, the Examiner's election of species requirement is believed to be improper. Nevertheless, Applicant has elected, with traverse, Species I, which is directed to Figures 1A, for which the Examiner has identified claims 12, 22, and 28 as generic, and Applicants have further identified claims 13 – 15, 17, 18, 20, 21 and 29 – 32 as readable on the elected species and generic to each of the identified species, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Chris Udo MAEDING


Neil F. Greenblum
Reg. No. 28,394

Robert W. Mueller
Reg. No. 35,043

August 10, 2009
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191